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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671

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EXAMINER

JOHNSON, MARLON B

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 04/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/385,802

Applicant(s)

BARTHOLOMEN DONOVAN,  
KEVIN REMINGTON JOS

Examiner

Marlon Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 August 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **Detailed Action**

### ***Oath/Declaration***

1. A new oath or declaration is required because the post office address and residence address of the inventor are not properly associated. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

### ***Claim Rejections 35 U.S.C. 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9, 10-12, 15, 19-20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In considering claim 9, claim 9 fails to further limit the base claim (claim 6), see claim 6, lines 12-13.
- In considering claim 10, at line 1, the phrase "each said is" has no clear antecedent basis. Should the phrase "each said is" read ---each said first and second PC is---?  
  
In claim 11, line 1, the phrase "said PC" is ambiguous because it is not clear as to whether "said PC" is referring to the first PC or the second PC.

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In claim 13, the phrase "The system of claim 13", line 1, is indefinite because the claim depends on itself. Should the phrase "The system of claim 13" reads ---The system of claim 12---? Further, "said PC", line 1, is ambiguous because it is not clear as to whether "said PC" is referring to the first PC or the second PC.

- In claim 15, line 1, the phrase "said PC" is ambiguous because it is not clear as to whether "said PC" is referring to the first PC or the second PC.
- In claim 19, lines 1-2, the phrase "the first to the second PC" has no clear antecedent basis.
- In claim 22, the phrase "said PCs" has no clear antecedent basis

*Claim Rejections – 35 U.S.C § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mozilla in lieu of Vaudreuil et al. Mozilla, discloses a distributed communication system in which a plurality of users associated with different realms (protocols) access the Internet via a corresponding PC through a service provider, a device for providing instant messaging between the users (lines 1-3 and 32-35).

Although Mozilla shows substantial features of the claimed invention, he is silent in regards to means associated with the PC of a first user and arranged to obtain a foreign protocol

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for communicating with another realm (protocol); and a server including a database with a listing of users currently connected to the Internet, each having a unique identifier, wherein means are arranged to receive the unique identifier of a particular user associated with the another realm (protocol) from the server and to establish connection to the other user using the foreign protocol.

Nevertheless, means for allowing a plurality of systems having varying protocols to communicate with each other over the internet is well known in the art and would have been an obvious modification of the system disclosed by Mozilla, as evidenced by Vaudreuil et al. Vaudreuil discloses means associated with the PC of a first user and arranged to obtain a foreign protocol for communicating with another realm (protocol); and a server including a database with a listing of users currently connected to the Internet, each having a unique identifier, wherein means are arranged to receive the unique identifier of a particular user associated with the another realm (protocol) from the server and to establish connection to the other user using the foreign protocol (see col. 6, line 18 to col. 7, line 41).

Because Mozilla is silent in regards to its protocol translation (and/or conversion) scheme (discussed above) a person having ordinary skill in the art would have readily recognized that any system having means for providing the details of protocol translation allowing a plurality of systems with different realms to communicate with each other of the internet would have satisfied the void of Mozilla. Thus, given the teaching of Vaudreuil et al., a person having ordinary skill in the art would have been motivated to modify Mozilla, by employing the details of the protocol translation scheme, so as to execute the cross realms communication, in order to

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make the system more flexible and extendable. Therefore, the claimed invention (claims 1, 9 and 16) would have been an obvious modification of the system disclosed by Mozilla.

Claims 2-5, 7-15 and 17 would have been an obvious modification of the combined teaching of Mozilla and Vaudreuil et al.

### *Conclusion*

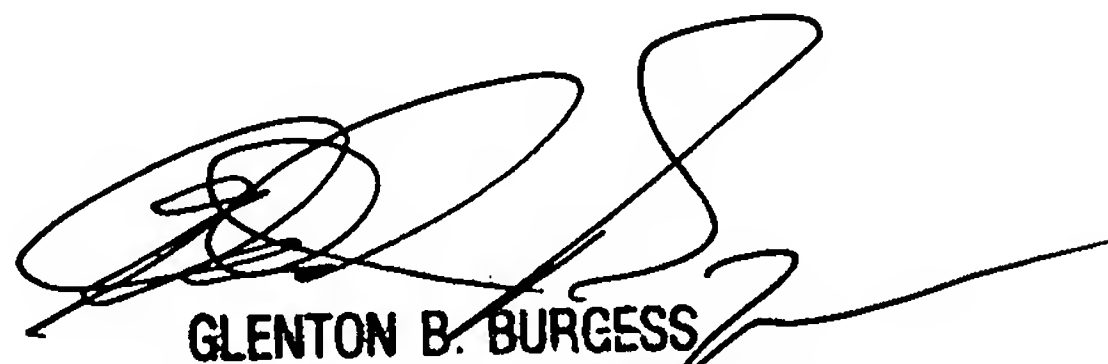
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon Johnson whose telephone number is (703) 305-4642. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3230.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 .

Marlon B. Johnson

  
GLENTON B. BURGESS  
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